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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/787,441

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Roberto Cavazzuti

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EXAMINER

VENKAT, JYOTHSNA A

ART UNIT

PAPER NUMBER

1615

DATE MAILED: 04/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/787,441	Applicant(s) CAVAZZUTI ET AL.	
	Examiner JYOTHSNA A. VENKAT Ph. D	Art Unit 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 104-119 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 104-119 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/27/04, 9/17/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt is acknowledged of preliminary amendment, petition to make special, IDS, terminal disclaimer and supplemental IDS filed on 2/27/04 and 9/17/04. The preliminary amendment canceled claims 1-103 and added claims 104-119. Claims 114-119 are pending in the application and the status of the application is as follows:

Claim Rejections - 35 USC § 112

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 104-108, and 112-115 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **This is written description rejection.**

To satisfy the Written description requirement, applicant must convey with reasonable clarity to one skilled in the art, as of the filing date that applicant were in possession of the claimed invention. Applicant's claims are drawn to a method of making mascara comprising including in said mascara polymer of formula I and **"when R⁴ is a direct bond to R³ or another R⁴ so that the nitrogen atom to which both R³ and R⁴ are bonded forms a part of heterocyclic structure defined by R⁴-N- R³".** There is no description in the specification for heterocyclic ring systems. Therefore it is the position of the examiner that claims employing the above language at the point of novelty, such as applicants', neither provides those elements did

Art Unit: 1615

not require practicing the inventions, nor “inform the public” during the life of the patent of the limits of the monopoly, asserted. The expression could encompass myriad of compounds and applicants claimed expression represents only an invitation to experiment regarding possible heterocyclic compounds.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 106, 110 and 114 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. The claims recite one compound and yet the claims are in Markush group format.

Deletion of “ chosen from “ is suggested to overcome the above rejection.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

Art Unit: 1615

the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 104-108, and 112-115 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. Patents 5,783, 657 ('657) and 6, 214, 329 ('329).

Claim construction

The claims recite "making up of eyelashes" which is applying Mascara to eyelashes.

The instant application is claiming a method of making-up eyelashes comprising applying to said eyelashes a mascara composition comprising:

1. At least one solid substance that has a melting point of about 45 degrees Celsius or greater
2. Polymer of formula I
3. At least one liquid fatty phase which is volatile oil (species is isododecane)
4. Water
5. At least one coloring agent
6. At least one preservative

7. The patent '657 teaches polymer claimed in the instant application (ingredient 2) having gel consistency and these gels are useful in personal care products where in some self-supporting consistency is desired. See the abstract, see cols. 3-4 and see col.3, line 24 where the patent teaches that these polymers are useful in eye-makeup. The eye make up products are Mascara, eye shadow and eyeliner. The patent suggests the usefulness of this polymer in the eye-make up art. The patent at col.17, lines 25-30 teaches that this polymer can be combined with water, colorants and fillers and also teaches adding volatile solvent. The fillers and waxes taught in the

Art Unit: 1615

patent belong to ingredient 1. The difference between the patent and the instant application is the patent does not teach the specific volatile solvent or preservatives. The patent '329 teaches Mascara product using specific volatile oil claimed at col.6, line 60 and at paragraph bridging cols. 8-9 the specific fillers claimed, and at col.9 pigments and under example 1 teaches preservatives which are the parabens. The patent '329 teaches waxes at col.5, lines 15-37. Both fillers and waxes are claimed in the instant application as ingredient 1.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions using the polymer of '657 and use it as Mascara taught by the patent along with water, volatile solvents, pigments, and use the specific volatile solvents of '329 expecting that the compositions are useful as Mascara. The motivation to combine the ingredients flows logically from the art for having been used in the same Mascara art. One of ordinary skill in the art would be motivated to combine the ingredients with the reasonable expectation of success that the compositions which has the polymer has the structured property and when this product is applied to eyelashes the polymer imparts glossy and non-migrating benefit and the non-migrating benefit is useful to the consumer because when the Mascara is applied to eyelashes it does not stick to hands, clothing. This is prima facie case of obviousness.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 104-119 are provisionally rejected under 35 U.S.C. 102(e) as being anticipated by copending Application No. 09/618,066 which has a common assignee with the instant

Art Unit: 1615

application. Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e), if published under 35 U.S.C. 122(b) or patented. This provisional rejection under 35 U.S.C. 102(e) is based upon a presumption of future publication or patenting of the copending application.

9. See the paragraph bridging pages 2-3 for eyelashes, pages 4-5 for ingredient (i), see pages 10-13 for the polymer and see page 13, lines 5-15 for the species claimed as the polymer, see page 19, lines 3-18 for volatile which is isododecane at lines 12 and 18, see page 20 lines 10-14 for neutralizing agents, water, preserving agents, see pages 22-24 for coloring agents, see page 24 for packaging article. The disclosure of the co-pending application direct to those skilled in the art to the claimed compositions without any need for picking, choosing, and combining various disclosures not directly related to each other, by the teaching of the cited co-pending application.

This provisional rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131. This rejection may not be overcome by the filing of a terminal disclaimer. See *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991).

10. Claims 104-119 are provisionally rejected under 35 U.S.C. 102(e) as being anticipated by copending Application No. 09/685,577 which has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e), if published under 35 U.S.C. 122(b) or

Art Unit: 1615

patented. This provisional rejection under 35 U.S.C. 102(e) is based upon a presumption of future publication or patenting of the copending application.

11. See the paragraph bridging pages 2-3 for eyelashes, pages 4-5 for ingredient (i), see pages 10-13 for the polymer and see page 13, lines 13-20 for the species claimed as the polymer, see page 19, lines 4-21 for volatile which is isododecane at lines 13 and 20, see pages 22-24 for coloring agent, see page 20, lines 3-15 for neutralizing agents, water, preserving agents, see page 24 for packaging article. The disclosure of the co-pending application direct to those skilled in the art to the claimed compositions without any need for picking, choosing, and combining various disclosures not directly related to each other, by the teaching of the cited co-pending application.


This provisional rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131. This rejection may not be overcome by the filing of a terminal disclaimer. See *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT Ph. D whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30: 1st Friday off.

Art Unit: 1615

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THURMAN K. PAGE can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JYOTHSNA A VENKAT Ph. D
Primary Examiner
Art Unit 1615
